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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,047	12/20/2000	Steve Okun	11271STUS01U	9953

7590 04/15/2004
Garlick & Harrison
P.O. Box 670007
Dallas, TX 75367

EXAMINER

MILLER, BRANDON J

ART UNIT PAPER NUMBER

2683

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,047

Applicant(s)

OKUN ET AL.

Examiner

Brandon J Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-29 is rejected under 35 U.S.C. 102(e) as being anticipated by Ahlberg.

Regarding claim 25 Ahlberg teaches a mobile station comprising: communication circuitry for processing wireless communication signals (see col. 7, lines 1-7 and FIG. 2). Ahlberg teaches audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker (see col. 6, lines 29-35 and col. 7, lines 7-11 & 18-22). Ahlberg teaches logic circuitry for prompting the mobile station to transmit a request that a specified message be played to the calling party to advise the calling party that the called party will be taking the call shortly, wherein the mobile station only transmits the request if the called party depressed a select button or key while being alerted that a call was coming in for the called party (see col. 8, lines 1-9 & 14-20 and FIG. 2).

Regarding claim 26 Ahlberg teaches wherein the logic circuitry also is for prompting the mobile station to transmit an indication that the called party is ready to take the call (see col. 8, 57-67).

Regarding claim 27 Ahlberg teaches a select button that is a keypad number button (see col. 6, lines 52-54 and FIG. 2).

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Regarding claim 28 Ahlberg teaches a mobile station comprising: communication circuitry for processing wireless communication signals (see col. 7, lines 1-7 and FIG. 2). Ahlberg teaches audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker (see col. 6, lines 29-35 and col. 7, lines 7-11 & 18-22). Ahlberg teaches logic circuitry for prompting the mobile station to complete call connection and then to transmit a message to the calling party to advise the calling party that the called party will be taking the call shortly (see col. 8, lines 1-10 & 14-20 and FIG. 2).

Regarding claim 29 Ahlberg teaches a mobile station wherein the message is only transmitted if the called party depressed a select button or key while being alerted that a call was coming in for the called party (see col. 8, lines 1-6 & 14-15 and FIG. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlberg in view of Cronin.

Regarding claim 30 Ahlberg teaches a device as recited in claim 29 except for a microphone that is muted until a called party depresses a select key indicating that he is ready to take the call. Ahlberg teaches not opening the microphone and the speaker of a cellular telephone until a called party depresses a select key indicating that he is ready to take the call

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(see col. 7, lines 1-11). Cronin teaches muting a microphone while transmitting waiting messages to a calling party (see col. 2, lines 31-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include a microphone that is muted until a called party depresses a select key indicating that he is ready to take the call because this would allow for improved communication control when a calling party has been placed on hold.

Regarding claim 31 Ahlberg teaches a device as recited in claim 29 except for a speaker that is muted until a called party depresses a select key indicating that he is ready to take the call. Ahlberg teaches not opening the microphone and the speaker of a cellular telephone until a called party depresses a select key indicating that he is ready to take the call (see col. 7, lines 1-11). Cronin teaches muting a microphone while transmitting waiting messages to a calling party (see col. 2, lines 31-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include a speaker that is muted until a called party depresses a select key indicating that he is ready to take the call because this would allow for improved communication control when a calling party has been placed on hold.

Claim Objections

Claims 26-27 and 29-31 objected to because of the following informalities: Claims 26-27 depend on cancelled claim 1 instead of independent claim 25, claim 29 depends on cancelled claim 4 instead of independent claim 28, and claims 30-31 depend on cancelled claim 5 instead of claim 29. Appropriate correction is required.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gutzmann U.S Patent No. 6,118,861 discloses a calling party invoked held call monitoring.

Nakamura U.S Patent No. 6,553,221 discloses incoming call notification apparatus.

Nguyen U.S. Patent No. 5,995,848 discloses a system and method of completing calls to busy mobile subscribers in a radio telecommunications network.

Ahlberg U.S. Patent No. 5,657,372 discloses systems and methods for selectively accepting telephone calls without establishing voice communications.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J Miller whose telephone number is 703-305-4222. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 10, 2004



**WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**